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| Zeichen/Ref./Réf. EP 22330 | Anmeldung Nr./Application No./Demande n°/Patent Nr./Patent No./Brevet n° 98116534.3 - 2304 / 0879703 |
| Anmelder/Applicant/Demandeur/Patentinhaber/Propriétaire/Titulaire CANON KABUSHIKI KAISHA | |

Appeal number:

T1094/05-3.2.05

Please find enclosed a copy of the decision dated 29.04.2008.

PROC DISP

Chyde
The Registrar D.Meyfarth
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Annex(es):

Registered letter with advice of delivery



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Boards of Appeal

Chambres de recours

Case Number: T 1094/05 - 3.2.05

DECISION
of the Technical Board of Appeal 3.2.05
of 29 February 2008

Appellant I:
(Opponent)

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Appellant II:
(Patent Proprietor)

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Decision under appeal:

Interlocutory decision of the Opposition
Division of the European Patent Office posted
1 July 2005 concerning maintenance of European
patent No. 0879703 in amended form.

Composition of the Board:

Chairman: C. Rennie-Smith
Members: W. Widmeier
P. Michel
H. Schram
M. J. Vogel

Summary of Facts and Submissions

- I. Appellant I (opponent) and appellant II (patent proprietor) lodged appeals against the interlocutory decision of the Opposition Division maintaining European patent No. 0 879 703 in amended form. The patent in suit is based on European patent application No. 98 116 534.3 which was a divisional application from European patent application No. 95 113 258.8 (the "earlier application").

The Opposition Division held that the grounds of opposition under Article 100(a) EPC (lack of inventive step, Article 56 EPC) and Article 100(c) EPC did not prejudice the maintenance of the patent in amended form.

- II. Oral proceedings before the Board of Appeal were held on 29 February 2008.
- III. Appellant I requested that the decision under appeal be set aside and that the European patent No. 0 879 703 be revoked, as first auxiliary request that the second and subsequent auxiliary requests of appellant II be not admitted into the proceedings, and as second auxiliary request that the case be remitted to the first instance for further prosecution on the basis of the amended fourth auxiliary request of appellant II.
- IV. Appellant II requested that the decision under appeal be set aside and the patent be maintained on the basis of either the main request or one of first to third auxiliary requests, all filed on 29 January 2008, or the fourth auxiliary request, filed during the oral proceedings.

V. Claim 1 of the main request reads as follows:

"1. A liquid container (30; 130; 140) for an ink jet recording apparatus, capable of containing liquid to be used by an ink jet head, wherein said liquid container (30; 130; 140) is detachably mountable to a holder (60; 160) having the ink jet head, said liquid container (30; 130; 140) comprising:

a main body for containing a liquid;

a supply port (32b; 132b; 142bY, 142bM, 142bC) for supplying the liquid to the ink jet head, said supply port (32b; 132b; 142bY, 142bM, 142bC) being disposed in a portion which forms the bottom of said container in operation;

a first engaging portion (32d; 132d; 142d) in the form of a claw portion, provided on a first side of said main body and adapted to be engaged with a first locking portion (60i; 160i) of the holder (60; 160) for pivotally holding said liquid container during mounting; and

a supporting member in the form of a latching member (32a; 132a; 142a; 632a; 732a) resiliently supported by said liquid container, and being extended in front of a second side opposite said first side and having a second engaging portion (32e; 132e; 142e) in the form of a latching portion at an outside thereof facing away from said second side of said main body and capable of moving away from and towards said second side which second engaging portion (32e; 132e; 142e) is adapted to engage with a second locking portion (60j; 167a; 167a') of the holder (60; 160; 560), wherein said supply port (32b; 132b; 142bY, 142bM, 142bC) is disposed between said first engaging portion (32d, 132d,

142d) and said second engaging portion (32e; 132e; 142e)."

Claim 1 of the first auxiliary request differs from claim 1 of the main request in that the term "latching member" is replaced by the term "latching lever".

Claim 1 of the second auxiliary request differs from claim 1 of the first auxiliary request by the insertion of the feature "for supporting said liquid container (30; 130; 140), while the elasticity of the supporting member (32a; 132a; 142a; 632a; 732a) supports and raises said liquid container (30; 130; 140) when said second engaging portion (32e; 132; 142e) is disengaged" before the last feature of the claim "wherein said supply port ...".

Claim 1 of the third auxiliary request differs from claim 1 of the second auxiliary request in that the term "claw portion" is replaced by the term "claw-like projection" and in that the term "latching portion" is replaced by the term "latching claw".

Claim 1 of the fourth auxiliary request differs from claim 1 of the third auxiliary request by the insertion "an air vent for fluid communication with ambience" between "which forms the bottom of said container in operation" and "a first engaging portion" and thus reads as follows:

"1. A liquid container (30; 130; 140) for an ink jet recording apparatus, capable of containing liquid to be used by an ink jet head, wherein said liquid container (30; 130; 140) is detachably mountable to a holder (60;

160) having the ink jet head, said liquid container (30; 130; 140) comprising:

- a main body for containing a liquid;

- a supply port (32b; 132b; 142bY, 142bM, 142bC) for supplying the liquid to the ink jet head, said supply port (32b; 132b; 142bY, 142bM, 142bC) being disposed in a portion which forms the bottom of said container in operation;

- an air vent for fluid communication with ambience;

- a first engaging portion (32d; 132d; 142d) in the form of a claw-like projection, provided on a first side of said main body and adapted to be engaged with a first locking portion (60i; 160i) of the holder (60; 160) for pivotally holding said liquid container during mounting; and

- a supporting member in the form of a latching lever (32a; 132a; 142a; 632a; 732a) resiliently supported by said liquid container, and being extended in front of a second side opposite said first side and having a second engaging portion (32e; 132e; 142e) in the form of a latching claw at an outside thereof facing away from said second side of said main body and capable of moving away from and towards said second side which second engaging portion (32e; 132e; 142e) is adapted to engage with a second locking portion (60j; 167a; 167a') of the holder (60; 160; 560) for supporting said liquid container (30; 130; 140), while the elasticity of the supporting member (32a; 132a; 142a; 632a; 732a) supports and raises said liquid container (30; 130; 140) when said second engaging portion (32e; 132; 142e) is disengaged, wherein said supply port (32b; 132b; 142bY, 142bM, 142bC) is disposed between said first engaging portion (32d, 132d,

142d) and said second engaging portion (32e; 132e; 142e)."

VI. The following documents were in particular referred to in the appeal procedure:

D1: EP-A-0 546 832

D2: EP-A-0 376 719

D4: US-A-4 408 914

D5: EP-A-0 378 240

VII. The arguments of appellant I can be summarized as follows:

The second and subsequent auxiliary requests should not be admitted into the proceedings because claim 1 of these requests comprises a feature which was not contained in any of the claims of the patent as granted and was taken from the description. As this could not be expected, these requests should be considered as late filed. These requests were filed only one month before the oral proceedings, a time period too short to perform a comprehensive search of the additional feature. The admission of these requests would be an unfair treatment of appellant I.

The air vent of the liquid container is disclosed in the earlier application as filed as an essential feature. The ink container would not work without this air vent or would require significant modification to work without it. Thus, the subject-matter of claim 1 of

the main request and of the first to third auxiliary requests extends beyond the content of the earlier application as filed.

As claim 1 of the fourth auxiliary request comprises features which were taken from the description, no analysis of inventive step can be made with respect to this claim. The case should be remitted to the first instance for consideration of the question of inventive step.

Claim 1 of the fourth auxiliary request relates to a liquid container, whereas the earlier application as filed was restricted to an ink container. The term liquid container is therefore an inadmissible generalization. A further extension is constituted by the first and second locking portions of claim 1 of the fourth auxiliary request. Such locking portions are nowhere disclosed in the earlier application as filed. The earlier application as filed also does not disclose a pivot movement of the ink container in the holder around the claw-like projection of the container. As is shown in the drawings of this application, the holder is a rectangular body and, when the container is inserted into the holder, the pivot movement is around the upper corner of the container rather than around the claw-like projection, see Figure 63. The claw-like projection is only disclosed as a disengagement preventing claw. The feature "supporting member in the form of a latching lever" extends beyond the earlier application as filed because this application discloses a latch lever which does not have a supporting function unless the ink container is in the holder and the latching is tight.

The patent in suit starts from document D1 as the closest prior art, which shows in Figure 2 a replaceable ink container which is detachably mountable to a holder. In the container-holder combination shown in this figure of document D1, the container carries the locking portions and the holder the corresponding engaging projections. In the patent in suit the holder carries the locking portions and the container the corresponding projections. Document D2, Figure 17, and document D5, Figures 3A and 3B, show ink containers which carry projections which engage with locking members of the holder. Thus, the combination of document D1 with either document D2 or document D5 leads to the subject-matter of claim 1 of the fourth auxiliary request. Document D4 discloses a snap-fit connection of a ribbon-cartridge and its holder. It is obvious to transfer this solution to the ink container of document D1 and thus to arrive at the subject-matter of the patent in suit. Thus, the combination of document D1 with document D4 also leads to the subject-matter of the patent in suit.

VIII. The arguments of appellant II can be summarized as follows:

The amendment to claim 1 of the second auxiliary request was a reaction to the communication of the Board of Appeal concerning the supporting function of the latch lever. Thus, this request and the subsequent auxiliary requests should be admitted.

The air vent of the liquid container is shown in only one figure, i.e. Figure 23, and mentioned only four

times in the description of the earlier application as filed. Although the air vent feature is comprised in claim 1 of that application it is not important for the object of the invention which is to provide a mounting aid for the container. The air vent is therefore to be considered as an optional feature which can be omitted. The subject-matter of claim 1 of the main and the first to third auxiliary requests thus does not extend beyond the content of the earlier application as filed.

A container for an ink jet printer can contain various kinds of liquid such as inks, cleaning liquids, etc. It is thus not an extension if this container is referred to as a liquid container as opposed to an ink container. The locking portion mentioned in claim 1 of the fourth auxiliary request is not part of the container; it is part of the holder. Any reference to the holder cannot influence the scope of the claim. The pivot movement is claimed as being around the claw-like projection. This pivot movement occurs at the end of the insertion process of the container rather than during the entire insertion process. The container and its holder constitute a form fit connection in which the latch lever has a supporting function. The subject-matter of claim 1 of the fourth auxiliary request therefore does not extend beyond the content of the earlier application as filed.

The subject-matter of claim 1 of the fourth auxiliary request differs from the disclosure of document D1 by the bottom location of the ink supply port, by the first engaging portion which enables pivotal holding during mounting, by the position of the supporting member and first engaging portion on opposite sides of

the container, and by a resilient second engaging portion on the outside of the supporting member. Figure 17 of document D2 shows a combination of a liquid container with an ink jet head which are connected together by a linear pushing movement. This document cannot therefore render the first engaging portion for pivotally holding the container obvious. Thus, even without the features which were taken from the description, the subject-matter of claim 1 of the fourth auxiliary request involves an inventive step. Document D4 was late filed and should not be admitted. In any case, it is irrelevant because mounting of ribbon cartridges and mounting of ink containers have nothing in common.

Reasons for the Decision

1. *Admissibility of second and subsequent auxiliary requests*

The Board considers the requests submitted by appellant II on 29 January 2008 as being a response to the communication of the Board of 30 November 2007, and also notes they were submitted within the time limit set in that communication. The feature "for supporting said liquid container (30; 130; 140), while the elasticity of the supporting member (32a; 132a; 142a; 632a; 732a) supports and raises said liquid container (30; 130; 140) when said second engaging portion (32e; 132; 142e) is disengaged", which is comprised in claim 1 of the second and subsequent auxiliary requests, is considered to be an attempt to define that the supporting member in the form of a latching lever has a

supporting function. This function was called into question in the communication.

The second and subsequent auxiliary requests are therefore admitted into the proceedings.

2. *Admissibility of late filed documents*

Document D4 was filed by appellant I because it shows the fixing of a printer element in a holder by means of a latch lever. For the reasons in 5.3 below, the Board considers that this document has no significance for the outcome of these proceedings and therefore the issue of its admissibility is also of no significance.

Document D5 shows a container-holder-combination similar to that shown in Figure 17 of document D2 and therefore does not introduce new and unexpected evidence.

The Board decided therefore in accordance with Article 114(2) EPC to admit documents D4 and D5.

3. *Main request and first to third auxiliary requests*

Claim 1 of the earlier application as filed comprises the feature that the ink container has an air vent for fluid communication with ambience. In the description of that application the air vent is also described as an element of the ink container (cf. column 4, lines 11 to 16; column 18, lines 7 to 10, 37 to 40 and 55 to 59; column 23, lines 24 to 27; column 23, line 58 to column 24, line 4; column 25, lines 48 to 54; and column 44, line 58 to column 45, line 7). Nowhere in

the description is the air vent described as being an optional feature which may be omitted. Thus, the earlier application as filed does not disclose a liquid container without an air vent. Claim 1 of the main request and the first to third auxiliary requests does not specify the presence of an air vent. The subject-matter of these claims therefore extends beyond the content of the earlier application as filed and does not meet the requirements of Article 76(1) EPC.

4. *Remittal on the basis of the fourth auxiliary request*

In accordance with Article 111(1) EPC it is within the discretion of the Board to exercise any power within the competence of the first instance or to remit the case to the first instance. As the feature of claim 1 of the fourth auxiliary request which was taken from the description is a clarification of the supporting function of the latching lever (see 5.1. below), rather than a new feature which would require a further search of prior art, the Board decided not to remit the case to the first instance for further examination.

5. *Fourth auxiliary request*

- 5.1 Claim 1 relates to a liquid container for an ink jet recording apparatus, capable of containing liquid to be used by an ink jet head. Claim 1 of the earlier application as filed relates to an ink container for containing ink to be supplied to an ink jet head. The functional feature "for containing ink" is interpreted as meaning that the container must be suitable for containing ink. It is clear from both claim 1 of the earlier application and claim 1 of the fourth auxiliary

request that the ink or liquid does not form part of the claimed container and that the container must simply be capable of containing liquid. Whether this liquid is ink or another liquid is irrelevant. The container will not experience any modification if it is filled with any kind of liquid other than ink. Thus, it makes no difference to designate the container of claim 1 "ink container" or "liquid container".

Consequently, even if the expression "liquid container" was not used in the earlier application as filed, this expression cannot extend the subject-matter of claim 1 beyond the content of this application. It also should be noted that the earlier application as filed uses the expressions "ink" and "liquid" synonymously, e.g. in column 14, lines 35 to 54.

The first and second locking portions of the holder mentioned in claim 1 are also not part of the claimed container. These locking portions express the function of the first and second engaging portions, and limit the claim to engaging portions which are adapted to carry out this function, i.e. to engage with a corresponding part of the holder. The engaging portions and their function are disclosed in the earlier application as filed (cf., for example, column 19, lines 21 to 35). Thus, the references to locking portions of the holder in claim 1 do not extend the subject-matter of this claim beyond the content of the earlier application as filed.

Whilst it is true that the ink container (cf. Figures 12 and 14 of the earlier application as filed) may contact the holder with its upper right corner so that this corner serves as a pivot axis when the

container is inserted at an angle into the holder, it is clear that, when approaching the end position of the container in the holder, the claw-like projection 32d comes into contact with the corresponding locking portion 60i of the holder, so that the container is pivotally held by this projection and the locking portion and the claw-like projection, rather than the corner of the container, serve as a pivot axis, see also column 26, lines 39 to 44 of the earlier application as filed. The expression "a claw-like projection ... for pivotally holding said liquid container during mounting" is thus in accordance with the disclosure of the earlier application as filed.

The earlier application as filed describes the latch lever and its function in column 20, lines 15 to 45, and column 39, lines 3 to 42. Although claim 1 of the fourth auxiliary request uses the term latching lever it is clear from the reference signs and from claim 1 of the earlier application as filed that the terms "latch lever" and "latching lever" mean the same. It is also clear from the cited parts of the earlier application as filed that the latching lever has, due to its elasticity, a supporting function, in that it supports the container to raise it from the holder. Thus, the expression "a supporting member in the form of a latching lever" and the definition of the supporting function "while the elasticity ... is disengaged" are disclosed in the application as filed. The latch lever knob is explained in the earlier application as being an additional part of the latching lever (cf. column 38, lines 25 to 27) which itself has no supporting function.

The subject-matter of claim 1 of the fourth auxiliary request therefore does not extend beyond the content of the earlier application as filed, so that the requirements of Article 76(1) EPC are met.

5.2 The subject-matter of claim 1 of the fourth auxiliary request is also disclosed in the application as filed so that the requirements of Article 123(2) EPC are also fulfilled. The same applies to the requirements of Article 123(3) EPC, since claim 1 of the fourth auxiliary request comprises all features of claim 1 as granted together with additional features which limit the scope of protection of the claim.

5.3 Documents D1, D2 and D5 show snap-fit connections of ink containers with printheads. In document D1, the printhead is equipped with two resilient latch members 12 which cooperate with corresponding fixed locking members 13 of the container (cf. Figure 2). In documents D2 and D5, the container carries resilient latch members which cooperate with corresponding fixed projections of the printhead (cf. in document D2 Figure 17 and in document D5 Figures 3A and 3B). Thus, these three documents show the same principle of connecting a container to a printhead, i.e. to connect container and printhead by means of a snap-fit connection, the resilient latch members being either on the printhead (document D1) or on the container (documents D2 and D5) and the corresponding locking members being on the respective other component. Neither of these documents show or suggest an engaging portion for pivotally holding the container during mounting. In the arrangements disclosed in these documents, container and printhead are coupled together

in a linear movement. These documents also do not show or suggest a supporting member in the form of a latching lever whose elasticity supports and raises the container when the other engaging portion is disengaged.

Thus, documents D1, D2 and D5, whether considered alone or in combination, do not suggest the subject-matter of claim 1 of the fourth auxiliary request.

Document D4 discloses a ribbon cartridge which is connected to a holder by means of bolts 16 and 17 and a resilient latch lever 18 (cf. Figure 1). Although this latch lever is comparable with the latching lever of the container of claim 1 of the fourth auxiliary request, document D4 does not suggest a claw-like projection for pivotally holding the cartridge during mounting. Thus, even if combined with one of documents D1, D2 and D5, document D4 would not lead to the subject-matter of claim 1 of the fourth auxiliary request. The admissibility of document D4 is therefore irrelevant (see 2 above).

For these reasons, the Board is convinced that the subject-matter of claim 1 of the fourth auxiliary request involves an inventive step and thus meets the requirements of Article 56 EPC.

6. The subject-matter of claims 2 to 25, which are dependent from claim 1, likewise involve an inventive step.

Order

For these reasons it is decided that:

1. The decision under appeal is set aside.
2. The case is remitted to the first instance with the order to maintain the patent on the basis of the following documents:
 - claims 1 to 25, filed as fourth auxiliary request during the oral proceedings,
 - description, page 3, as filed on 29 January 2008, pages 2, 4 to 23, as granted,
 - drawings, as granted.

The Registrar:



D. Meyfarth

The Chairman:



C. Rennie-Smith

